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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/019,011 02/18/93 DEAN

T 1158C

FORD, J. EXAMINER

12M2/0411

LOWE, PRICE, LEBLANC AND BECKER  
99 CANAL CENTER PLAZA, SUITE 300  
ALEXANDRIA, VA 22314

ART UNIT	PAPER NUMBER
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1202

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DATE MAILED: 04/11/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 2/27/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re-Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1--3, 5, 6, 18--20, 23, 24, 27--29 and 32 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1--3, 5, 6, 18--20, 23, 24, 27--29 and 32 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received.  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

Art Unit 1202

Applicants response of Feb. 22, 1994, is noted.

The terminal disclaimer of Feb. 28, 1994, has been entered under 37 CFR 1.321.

The claims in the application are claims 1-3, 5, 6, 18-20, 23, 24, 27-29 and 32.

All claims are rejected as not being patentably distinct from the claims of applicants U.S. Patent 5,153,192. Compare the claim 1 of the patent to claim 19 here. Compare claims 4-11 of the patent to claims 20, 23, 24, 27-29 and 32 here. No patentable distinction is seen. See the last Office Action.

The third compound from the end of claim 19 is a 2-propyl of the same compound that is the 2-methyl, that is the first compound of claim 1 of U.S. Patent 5,153,192. This is extremely close, in an otherwise identical molecule, for the same use. The first compound of claim 19 is extremely close to the 2(2-methoxy ethyl) compound that is penultimate in the list of claim 1 of US 5,153,192 -

- that is an ethyl vs. propyl variation. Next adjacent compounds are obvious from one another. A terminal disclaimer is minimally required.


Art Unit 1202

Claims 1-3, 5, 6, 18-20, 23, 24, 27-29 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 4-11 of U.S. Patent No. 5,153,192. Although the conflicting claims are not identical, they are not patentably distinct from each other because next adjacent compounds are being claimed here.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

Ford: ach  
April 07, 1994

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP 120